

REMARKS

Applicant respectfully requests reconsideration of this application. Claims 1-30 are pending. Claims 1-3, 8-10, 12, 16, 18, 24, 25, and 27 have been amended. No claims have been cancelled. Claims 31-36 have been added. Therefore, claims 1-36 are now presented for examination.

Claim Rejection under 35 U.S.C. §102

Harari, et al.

The Examiner rejected claims 1, 5, 9, 16, 20, and 24 under 35 U.S.C. § 102 (b) as being anticipated by U.S Patent 6,266,724 of Harari, et al. (“Harari”).

Claim 1, as amended herein, reads as follows:

1. A circuit comprising:

a first device coupled with a first bus, wherein the first device is not compliant with a standard, the first device containing data;

a second device coupled with a second bus, wherein the second device is compliant with the standard, the second device to be a temporary target for the data from the first device; and a memory to receive the data from the first device.

In addition to other differences, Harari does not teach or suggest a first device coupled with a first bus and a second device coupled with a second bus. If it is assumed that element 10 (the “mother card”) of Figure 1 is a device that is compliant with a standard and that element 20 (the “daughter card”) of Figure 1 is a device that is not compliant with the standard, then the daughter card is not coupled with a first bus, but is rather coupled with the mother card. If the mother card is coupled with a bus, then it

appears that the daughter card will utilize this bus through the mother card. The daughter card is not coupled with a bus that is not compliant with the standard.

It is submitted the above argument also applies to the other independent claims, as amended herein, claims 9, 16, and 24. The remaining claims are dependent claims and are allowable as being dependent on the allowable base claims.

Claim Rejection under 35 U.S.C. §103

Harari, et al.

The Examiner rejected claims 2-4, 8, 10-13, 17-19, 23, and 25-28 under 35 U.S.C. § 103 (a) as being unpatentable over Harari.

The rejected claims are allowable as being dependent on the allowable base claims, as indicated above.

With regard to claims 3, 12, 18, and 27, the Office Action indicates that it would have been obvious to “get the advantage of having knowledge of a peripheral device which will be receiving data before transmitting the data to the peripheral device in order to prevent transmission errors.” The Office Action further states that it would have been obvious to “scan the plurality of standard device to identify the second device to get this advantage.” It is respectfully submitted that this rejection is unsupported by the reference and by the law. The Office Action only indicates that it would somehow be known to get the advantage of the device, and that it would be somehow be known to scan a plurality of devices to identify the second device. The Office Action is thus using the advantage of the invention in hindsight to show obviousness, which is not proper in a rejection under 35 U.S.C. § 103 (a).

In addition to other differences, it is noted that claim 3 includes a controller that is coupled with the first bus and coupled with the second bus, and there is no teaching or suggestion of this element in the claims. It is respectfully submitted that this argument also applies to claim 18, as well as to new claims 32 and 35.

Claim Rejection under 35 U.S.C. §103

Harari, et al. in view of Eidson, et al.

The Examiner rejected claims 6-7, 14-15, 21-22, and 29-30 under 35 U.S.C. § 103 (a) as being unpatentable over Harari and further in view of U.S Patent 2004/0098516 of Eidson, et al. (“Eidson”).

The rejected claims are allowable as being dependent on the allowable base claims, as indicated above.

In addition, it is submitted that the references do not teach or suggest the elements of the rejected claims. Eidson discusses a method of implementing a system that includes storing system boot instructions on a programmable, non-volatile memory coupled to a bus that is configured after the boot sequence. (See, e.g., Eidson, summary)

It is submitted that the reference does not contain the elements missing from Harari, as shown above. For this reason, Eidson and Harari, separately or in combination, cannot show the elements of the claims. Eidson deals with a different issue, which is accessing a bus that is not configured until after a system boot.

Further, it is submitted that Eidson and Harari are not properly combinable because there is no proper motivation for the combination. The Office Action states that one would have been motivated to use Harari’s flash memory to store an operating system because Flash memory is reprogrammable, relatively fast, and reasonable

economical. This may provide a basis for a choice of a particular kind of memory, but it is not motivation for combining the references.

Eidson already discusses Flash memory at length, and the inventor was obviously well aware of and using the concept. The use of Flash memory in Harari does not add anything to Eidson, and Eidson is not relevant to the discussion in Harari. Finding a common technology like Flash memory that happens to be utilized in multiple references cannot in itself be used to justify combining the references. The use of Flash memory is not the point of either reference. If this could be used as motivation, then any reference regarding an automobile could be combined with any reference regarding a train locomotive because the subject of each reference has wheels, and the technology of wheels is very useful for either cars or locomotives. The use of Flash memory provides no motivation for applying the relevant portions of Harari to Eidson.

Claim Rejection under 35 U.S.C. §101

The Examiner rejected claims 24-30 under 35 U.S.C. 101 as being unpatentable because claim 24 is not limited to tangible embodiments.

The Applicant traverses the rejection and asserts that such rejection is contrary to law and contrary to the current policies of the Patent Office as expressed in the “Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility” (herein after referred to as the “Guidelines”).

There is no statutory basis for the rejection of claims bases on what is referred to as “intangible” embodiments in the Office Action. Further, in modern electronics, the distinction between tangible and intangible is specious. Instructions may exist in any form for the purpose of execution.

In fact, the Guidelines implicitly allow the use of carrier waves. The Guidelines divide material into “functional descriptive material” and “nonfunctional descriptive material”:

Descriptive material can be characterized as either “functional descriptive material” or “nonfunctional descriptive material.” In this context, “functional descriptive material” consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of “data structure” is “a physical or logical relationship among data elements, designed to support specific data manipulation functions.” The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) “Nonfunctional descriptive material” includes but is not limited to music, literary works and a compilation or mere arrangement of data.

(Guidelines, p 50) It is clear that the claim in question contains functional language that describes instructions to be executed by a machine, which imparts functionality to the machine. The elements of the claims thus are not “nonfunctional descriptive material”, which, as indicated in the Guidelines, may include music, literary works, and a compilation or mere arrangement of data.

The Guidelines then go on indicate that nonfunctional material on a medium, including a carrier signal, is not statutory:

When nonfunctional descriptive material is recorded on some computer-readable medium, in a computer or on an electromagnetic carrier signal, it is not statutory since no requisite functionality is present to satisfy the practical application requirement. Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored in a computer-readable medium, in a computer, on an electromagnetic carrier signal does not make it statutory. See Diehr, 450 U.S. at 185-86, 209 USPQ at 8 (noting that the claims for an algorithm in Benson were

unpatentable as abstract ideas because “[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer.”). Such a result would exalt form over substance. ...

(Guidelines, p. 51) (emphasis added) However, this implies that functional material recorded on a carrier wave is statutory. What the Guidelines indicate is that nonfunctional material that is recorded on “some computer-readable medium, in a computer or *on an electromagnetic carrier signal*” is not statutory. This has no relevance to functional material, which is what is contained in the claims. Also see the following:

When nonfunctional descriptive material is recorded on some computer-readable medium, in a computer or on an electromagnetic carrier signal, it is not statutory and should be rejected under 35 U.S.C. § 101. In addition, the examiner should inquire whether there should be a rejection under 35 U.S.C. § 102 or 103. The examiner should determine whether the claimed nonfunctional descriptive material be given patentable weight. The USPTO must consider all claim limitations when determining patentability of an invention over the prior art. ...

(Guidelines, p. 51) (emphasis added)

Further, the Guidelines provide the following regarding a rationale for rejection of data structures, which is that such structures are not capable of causing a functional change in a computer:

Data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer. See, e.g., Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure’s functionality to be realized. In contrast, a claimed computer-

readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory.

(Guidelines, p. 52) (Emphasis added) It is without question that instructions that are embodied in carrier waves or other propagation medium via a communication link are capable of causing functional change in a computer. Thus, the Guidelines cannot be logically referring to these in this statement. The function of instructions and the effect of such instructions on computers is not dependent on the type of media that is used. The Guidelines refer only to data structures that are not in any "media" and thus cannot have any functional effect on a computer, which is not the case with carrier waves or similar media. These do "permit the data structure's functionality to be realized", and thus are statutory. The Guidelines further indicate that a "signal" encoded with functional descriptive material does create a functional interrelationship with a computer:

On the other hand, from a technological standpoint, a signal encoded with functional descriptive material is similar to a computer-readable memory encoded with functional descriptive material, in that they both create a functional interrelationship with a computer. In other words, a computer is able to execute the encoded functions, regardless of whether the format is a disk or a signal.

(Guidelines, p. 57) Thus, the fact that instructions are embodied in signals does not affect the patentability of the invention.

Based on the foregoing, it is submitted that the rejected claims do qualify as statutory subject matter, and are patentable under the provisions of 35 U.S.C. § 101.

Conclusion

Applicant respectfully submits that the rejections have been overcome by the amendment and remark, and that the claims as amended are now in condition for allowance. Accordingly, Applicant respectfully requests the rejections be withdrawn and the claims as amended be allowed.

Invitation for a Telephone Interview

The Examiner is requested to call the undersigned at (503) 439-8778 if there remains any issue with allowance of the case.

Request for an Extension of Time

The Applicant respectfully petitions for a one-month extension of time to respond to the outstanding Office Action pursuant to 37 C.F.R. § 1.136 (a). A check is enclosed for the necessary fee under 37 C.F.R. § 1.17 for such an extension.

Charge our Deposit Account

Please charge any shortage to our Deposit Account No. 02-2666.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

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